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09/812,952	03/27/2001	Toru Teshima		5247

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LORUSSO & LOUD
3137 Mount Vernon Avenue
Alexandria, VA 22305

EXAMINER

PHU, SANH D

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,952

Applicant(s)

TESHIMA, TORU

Examiner

Sanh D Phu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 13-25 and 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the applicant's response filed on 2/7/05.

Claim Rejections – 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is

determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 3, 6-9, 12 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Calvert (6,526,275), newly-cited.

-Regarding to claim 1, see figures 1 and 2 and col. 4, line 1 to col. 11, line 33, Calvert discloses a method (see figure 1) comprising:

step (101) of transmitting current position information, by a wireless electronic communication (215, 217, 201) (see figure 2), from a mobile communication instrument (101) to an advertisement information delivery apparatus (104, 107, 109); and

step (104) of delivering advertisement information from the advertisement information delivery apparatus to the mobile communication instrument based on the current position information (see col. 7, line 45 to col. 10, line 50).

-Regarding to claim 3, see figures 1 and 2 and col. 4, line 1 to col. 11, line 33, Calvert discloses a system (see figure 1) comprising:

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advertisement delivery apparatus (104, 107, 109) including advertisement information storage means (109) for storing advertisement information to be delivered to a mobile communication instrument (101) at a location designated by a sponsor (213) of the advertisement information (see col. 5, line 5 to col. 10, line 50);

a mobile communication instrument (101) for detecting current position and transmitting the detected current position to the advertisement delivery apparatus, for receiving said advertisement information and for outputting an advertisement based on the received advertisement information (see figure 2, and col. 6, line 5 to col. 8, line 5); and

wherein said advertisement information delivery apparatus retrieves, from said advertisement information storage means, advertisement information relating to the designated location, responsive to the detected current position agreeing with or being proximate to the designated location, and delivers the retrieved advertisement information to said mobile communication instrument (see col. 5, line 5 to col. 10, line 50).

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–Regarding to claim 6, Calvert discloses that the advertisement information stored in said advertisement information storage means includes image data picturing an advertisement including at least one of trade name, business content, brand name and guide map (see col. 9, lines 46–52), and said mobile communication instrument includes a display screen (209) for displaying the pictured advertisement based on said image data (see figure 2, and col. 10, lines 33–50).

–Regarding to claim 7, Calvert discloses said advertisement information storage means stores location position information for retrieving a “direction” as “a path” from a current position to an advertised location (see col. 9, lines 35–52) and said mobile communication instrument includes a display screen for displaying said path (see col. 10, lines 33–50).

–Regarding to claims 8 and 9, Calvert discloses that comprising delivery condition storage means included in (109) for storing at least one delivery condition for the advertisement information, whereby said advertisement information delivery means determines delivery to said mobile communication instrument according to said delivery condition wherein said delivery condition

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is at least one of presentation calendar period, presentation time of day, age group, and gender(s) (see col. 15, lines 45–67).

–Regarding to claim 12, Calvert discloses that said mobile communication instrument is a mobile telephone (see col. 4, lines 34–36), and said mobile telephone is provided with current position detecting means (219, 221) for detecting its own current position (see figure 2).

–Regarding to claim 26, see figures 1 and 2 and col. 4, line 1 to col. 11, line 33, Calvert discloses a system (see figure 2) comprising:

current position detecting means (221) for detecting current position;
a display screen (209) for displaying picture images;
storage means (207) for storing advertisement information related to a designated location where advertisement information is to be presented; and
advertisement presentation control means (205) for presenting advertisement information relating to the designated location on said display screen when the detected current position agrees with the designated location.

Claim Rejections – 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calvert.

–Regarding to claims 10 and 11, that said mobile communication instrument is a device (221, 215, 203), said device comprising a navigation (221), a transmitter (215) for transmitting current position information to said advertisement information delivery means, and a receiver (203) for receiving the advertisement information (see figure 2). Calvert does not disclose that said a device (221, 215) carried by a vehicle. However, since said device (221, 215) can be incorporated within a mobile, portable phone “cellular phone” (see col. 4, line 35), it would have been obvious for one skilled in the art that said

Calvert device (221, 215) being incorporated within a mobile, portable phone “cellular phone” could be carried on a vehicle, without affecting the overall system performance. Further regarding to claim 11, since being incorporated within a mobile, portable phone “cellular phone”, said device (221, 215) inherently transmits current position information to and receives advertisement information from advertisement information delivery means through said mobile, portable phone “cellular phone”.

6. Claims 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calvert in view of Owensby (6,647,257), previously cited.

–Regarding to claims 4 and 5, Calvert does not disclose that said advertisement information delivery apparatus further includes delivery data storage means for storing number of deliveries of advertisement information to mobile communication instruments or for storing number of times mobile communication instruments are to be a delivery target of advertisement information, each time advertisement information is delivered thereto.

Owensby teaches storing/recording information (Historical Response data) about history of deliveries of advertisement information to mobile

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communication instruments or the like for permitting messages, commercial information and advertisements to be targeted to as broad or narrow arrange of subscribers as desired by the sponsor of the message (see col. 5, lines 35–45).

Therefore, it would have been obvious for a person skilled in the art, when building or carrying out Calvert invention, within his skills and upon his design preference or system requirement, to implement storage means included in said advertisement information delivery apparatus (109) (see figure 1) for storing such as number of deliveries of advertisement information to mobile communication instruments or for storing number of times mobile communication instruments are to be a delivery target of advertisement information, each time advertisement information is delivered thereto, as history of deliveries of advertisement information, as taught by Owensby, so that said advertisement information delivery apparatus would permit messages, commercial information and advertisements to be targeted to as broad or narrow arrange of subscribers as desired by the sponsor (120) of the message.

–Regarding to claim 2, see figures 1 and 2 and col. 4, line 1 to col. 11, line 33, Calvert discloses a method (see figure 1) comprising:

step (109, 120) of designating, by a sponsor (120) of the advertisement information, a location at which the advertising information is to be delivered to a mobile communication instrument (101);

step (109) of storing in memory the advertisement information to be presented at the designated location;

step (101) of transmitting information for the current position of the mobile communication instrument from the mobile communication instrument to an advertisement information delivery apparatus (1404, 107, 109) remote from the mobile communication instrument and including the memory (109);
and

step of (104, 107, 109) retrieving advertisement information relating to the current position from the memory based on the current position information received from the mobile communication instrument, and delivering the retrieved advertisement information to the mobile communication instrument.

Calvert further discloses that the sponsor may offer paying the delivery cost (see col. 9, lines 39–40).

Calvert does not disclose step of calculating advertisement delivery charges for the delivery; and charging, or liquidating by payment, the calculated advertisement delivery charges to the sponsor.

Owensby disclose step of calculating advertisement delivery charges for the delivery; and charging, or liquidating by payment, the calculated advertisement delivery charges to a payee (see col. 2, line 65 to col. 3, line 2, and col. 15, line 24–31).

It would have been obvious for one skilled in the art to implement Calvert invention with step of calculating advertisement delivery charges for the delivery; and charging, or liquidating by payment, the calculated advertisement delivery charges to the sponsor (as the payee), as taught by Owensby, so that the delivery would be paid by the sponsor.

Response to Arguments

7. Applicant's arguments, filed on 2/7/05, have been fully considered and are persuasive. Therefore, the previous rejection to claims 1–12 and 26 has

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been withdrawn. However, upon further consideration, a new ground(s) of rejection is made, as set forth above in this Office Action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanh D Phu whose telephone number is (703)305-8635. The examiner can normally be reached on 8:00-16:30.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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